REMARKS

Claims 1-44 are presently pending. In the above-identified Office Action, Claims 25-44 were withdrawn from consideration. Examiner objected to Claim 1 for the use of the term *capable of*. Claims 1-11 and 15-24 were rejected under 35 U.S.C. 102(e) as being anticipated by Weichert et al. (US 2004/0117302, herein after Weichert). Claims 12-14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Weichert in view of Kipp (U.S. Patent No. 5,239,167).

By this Amendment, Applicant has cured the objections to the present Application. For the reasons set forth below, the present Application is submitted as properly defining an invention patentable over the prior art. Reconsideration, allowance, and passage to issue are respectfully requested.

Examiner's Objections

The objection to Claim 1 was obviated by an amendment to Claim 1, wherein the term *capable of* was replaced with the term *for*.

Rejections Under 35 U.S.C. 102(e)

The invention is set forth in claims of varying scope. Claim 1 is illustrative. Claim 1 recites:

> 1. A system for facilitating transactions comprising:
> a charging terminal for charging an account based on an account number;
> a scanner for obtaining biometric information; and
> first means for employing said biometric information to automatically provide an account number to said charging terminal. (Emphasis added.)

In rejecting Claim 1 under 35 U.S.C. 102(b), Examiner suggests or implies that Weichert discloses a payment management system that includes a Point-Of-Service

(POS) terminal 508 (Fig. 5) capable of charging an account via a card/check reader 512 and payment enabler 170 (Fig. 1); a biometric reader 516 (Fig. 5); and a payment system 140 (Fig. 2), that anticipate the invention as claimed.

However, Weichert neither teaches, discloses, nor suggests a mechanism for employing biometric information to automatically provide an account number to a charging terminal. Instead, in Weichert, the account number is manually entered into the system, such as via the card/check reader 512 or via a pull-down selection list 702 (Fig. 7A of Weichert). At minimum, Weichert requires a user to login to an account by manually selecting a login button (Figs. 6A-6D, Figs. 8A, 8B). After login, the user must apparently still navigate user interfaces, such as the checkout interfaces of Figs. 9A and 9B to complete checkout and authorize a transaction. Only after a transaction is manually authorized would any relevant account information, such as account numbers, be sent to a charging terminal, such as the payment enabler 170 and/or one of the money handlers 160.

The fact that Weichert requires manual manipulation, and account numbers are not automatically retrieved, is further substantiated with reference to the method flow diagrams of Figs. 11A and 12. For example, Fig. 11A discloses step 1120 (as discussed on page 9, column 1, paragraph 96), which involves checking if a user has an account. This implies that a user manually enters account information to login, to create an account, or to otherwise interact with the system. Such interaction should not be construed as automatic retrieval of account information. Step 1132 may involve verifying manually or machine-entered (magnetic stripe) account information (last half of paragraph 96) *and* biometric information, which suggests that the account information was previously entered (not automatically sent to a charging terminal in response to or based on biometric information) in step 1120 or 1124.

Similarly, Fig. 12A of Weichert also discloses step 1120. Note that Fig. 12A explicitly indicates that account information is provided (in step 1212) before biometric information is gathered (in subsequent step 1216). Hence, the biometric information employed by Weichert, and as discussed with respect to Fig. 12A, is apparently not employed to retrieve account information, which is retrieved *before* biometric

information. Weichert merely employs biometric information for authentication/identification purposes and not to select an account number for retrieval as claimed.

While Weichert purportedly suggests that biometric information may be employed authenticate a user for access to an account via a POS terminal (as disclosed in paragraph 86 and in the last quarter of paragraph 78 of Weichert), nowhere does Weichert suggest that an account number is automatically provided to the POS terminal based on biometric information. Note that the interface of Weichert, such as the interface of Fig. 7B, does not show account *numbers*. Rather, the interface of Fig. 7B shows bank names. Account numbers are apparently only displayed after a transaction has been manually authorized (such as by selecting the *authorize* buttons of the interfaces of Figs. 7A, 7B and Fig. 9A, 9B), and the transaction is completed (Figs. 10A, 10B), or when manually configuring an account-prioritization screen (Fig. 13). Nowhere does Weichert suggest that account numbers are automatically provided to the POS terminal 86 via biometric information. Even if Weichert suggested that account numbers were automatically provided to the POS terminal 86 in response to receipt of biometric information, Weichert would not teach the invention as claimed, since *the POS terminal 508 of Weichert is not a charging terminal*, as discussed more fully below.

Note that mere access to an account that may include an account number (such as credit card numbers) does not suggest that the account number is automatically provided to a charging terminal. To the contrary, Weichert suggests that after the account is accessed, the relevant numbers must still be manually accessed (not automatically retrieved), such as by employing an account selection field 702 (Fig. 7A), and/or manually selecting the login button, as shown in Figs. 6B and 8B. Note that Weichert implies that account information is accessed, not *automatically* delivered, provided, or otherwise sent to a charging terminal.

Hence, Weichert generally requires manual manipulation of an interface (such as 180 of Figs. 1and 2, 508 of Fig. 5, etc.) at the Point Of Sale (POS). The interface may include various pull-down menus and fields (as shown in Figs. 6-9 of Weichert), which

require manual manipulation, and hence, do not suggest automatic retrieval of account information via biometric information as claimed.

Furthermore, in Weichert, the POS terminal 508 *is apparently a user interface POS terminal (one of the user interfaces 180 of Fig. 1) and is apparently not a charging terminal*, as the term is used in the present Application. Instead, the payment enabler 170 (or one of the money handlers 160) may actually be the charging terminal of Weichert. Note that the payment enabler 170 implements the billing function 312 and may issue invoices (last sentence of paragraph 58). Furthermore, note that an ATM machine, which might constitute a charging terminal, may include the money handler 160 (paragraph 44). In addition, note that a credit card terminal 160-2 and a debit card terminal 160-3 are purportedly considered to be money handlers 160 (Figs. 1 and 2). These terminals, which might be considered charging terminals, are not the POS terminal 508 (Fig. 5). Weichert does not anticipate employing biometric information to automatically deliver account numbers to the terminals 160.

Hence, in Weichert, any accessed account numbers are *accessed* via an interface and not automatically sent to a charging terminal. To the contrary, the payment information is maintained at the charging terminal 170, such as in the user database 324 (as shown in Fig. 3 of Weichert) and, consequently, the payment information is not automatically delivered thereto, i.e., to where the payment information is already stored.

The conclusion that the POS terminal 508 is not a charging terminal is further supported by paragraph 36 of Weichert with reference to Fig. 2. In particular, paragraph 36 suggests that a computer, phone (such as the phone interface 180-5 of Fig. 2), a POS terminal, and any of the user interfaces 180 may be employed to communicate with the payment enabler 170. The POS terminal, i.e., interface 180-7 of Fig. 2 is likely grouped with other user interfaces, because it is one.

This conclusion is additionally supported by the fact that the screens on the POS terminal 508 are formulated by the payment enabler 170 (page 6, column 2, bottom half of paragraph 70). If the POS terminal 508 were the actual charging terminal, then surely the POS terminal 508 would communicate with the merchant clearing component 416 and would not require communicating first with the payment enabler 170 via the WAN

424. The accompanying card/check reader 512 appears to merely be a data-input device that forwards information to the payment enabler 170 via the POS terminal 508, retail merchant server 504, and WAN 424 (Fig. 5).

Since Claim 1 as amended is not taught, disclosed, or suggested by Weichert, the corresponding dependent Claims 2-14 are also necessarily not taught, disclosed, or suggested by Weichert. Nevertheless, the following discussion of the rejections pertaining to each claim further exemplifies how the claims distinguish over the art of record.

Regarding Claim 2, Examiner suggests that Weichert discloses a credit card or ATM terminal and that the account number delivered to the credit card or ATM terminal includes a credit card number and corresponding expiration date or ATM number and a corresponding PIN. Examiner further suggests that the various money handlers 160 and interfaces 180 may be employed to complete various financial transactions using the payment enabler 170.

However, if these numbers (credit card numbers, expiration dates, ATM numbers, and PINs) are used by the payment enabler 170, they are not automatically delivered thereto in response to user-provided biometric information, since these numbers would already be maintained at the payment enabler 170, such as in the user database 324 of the payment enabler 170 (as shown in Fig. 3). For the money handlers 160 to use such numbers, a user would first have to *manually* authorize a transaction, such as by selecting an authorize button (Figs. 9A and 9B) before any number would be transferred to credit card terminal 160-2 or debit card terminal 160-3 of Fig. 2. Hence, Weichert does not employ biometric information to automatically provide, deliver, or send an account number, including an ATM and PIN or a credit card number and expiration date, to a charging terminal as recited in Claim 2.

Regarding Claim 3, Examiner suggests that Weichert discloses a means for automatically selecting from among plural accounts based on biometric information ([0077]-[0084], Figs. 6C-7B) and thereby anticipates the invention as recited in Claim 3.

However, Weichert does not disclose employing biometric information to automatically select an account from amount plural accounts and to automatically

provide the selected account number to the charging terminal in response thereto. Rather Weichert generally uses biometric information for authentication, i.e., to verify the identity of a user to facilitate account login. After login, the user manually selects an account, such as via the account pull-down field 702 (Figs. 7A, 7B). Hence, the account is not automatically selected from among plural accounts of the user based on which biometric information is input to the system.

Nowhere does Weichert suggest that an account is selected based on which type of biometric information is submitted. For example, unlike Weichert, an embodiment of the invention as claimed in Claim 3 might enable a user to select an American Express card when providing biometric information via his right iris and to select a particular Visa(R) when providing biometric information via his left eye.

Applicant has modified Claim 3 to further clarify Applicant's intended claim. In particular, the phrase "based on said biometric information" was repositioned in the claim, and the term -- an account– was inserted after "said biometric information" to avoid potential confusion as to whether the accounts are based on biometric information or whether selecting is performed based on biometric information.

Regarding Claim 4, Examiner suggests that Weichert discloses, in addition to the system of Claims 1 and 3, a means (such as interfaces 180 of Fig. 2) for enabling a user to control which account number is selected by the first means (pull-down field 702, paragraph 80 and Figs. 7A and 7B).

However, any selection of an account from the pull-down field 702 by a user would not constitute automatic selection based on biometric information. Instead, such a selection would constitute a manual selection via the pull-down menu. For example, Weichert does not anticipate enabling a user to configure the system to automatically select one card in response to biometric information pertaining to the left eye and another card in response to biometric information pertaining to the right eye.

Regarding Claim 5, Examiner suggests that Weichert discloses a means (enabler interface 320) for enabling a user to prioritize plural accounts (Fig. 13), an available account with the highest priority ([0084]) being automatically selected based on biometric information (by the first means).

However, Weichert does not teach, disclose, or suggest a means for a user to prioritize accounts so that the highest priority account is automatically selected by the first means. Instead, Weichert merely suggests prioritizing accounts according to a scheme. To use a pull-down field, such as the field 702, a user would manually (not automatically and not based on biometric information) select the pull-down arrow to the right of the field 702 to access the corresponding list of account information 706. Furthermore, note that the account information 706 is a list of bank names and not a list of numbers. Nowhere does Weichert teach, disclose, or suggest that an account number is automatically provided to a charging terminal as recited in Claim 1; certainly Weichert does not disclose use of biometric information to facilitate automatically providing an account number to a *charging terminal*.

Regarding Claim 6, Examiner suggests that Weichert discloses an enabler interface 320 of Fig. 3 that is sufficient to anticipate software that enables a user to trigger automatic selection of an account based on which type of biometric information or combination of biometric information that a user provides, as purportedly discussed in paragraph 63 of Weichert.

However, the enabler interface 320 merely allows a user to create and maintain an account, transfer money, configure handlers (such as handlers 160 of Fig. 2), and to learn to use the system. Nowhere does Weichert suggest that the enabler interface 320 could enable, for example, a user to trigger selection (let alone automatic selection) of an account based on whether the user provides biometric information pertaining to facial scan, an iris scan of one eye, a combination of a thumb print and a voice scan, etc., as enabled by an embodiment according to Claim 6. The features recited in various claims, such as Claim 6, are particularly beneficial, enabling users to associate different body parts or other biometric information or combinations thereof with different account numbers. This may eventually obviate the need for a user to carry any card, including a drivers license, as the biometric information may enable retrieval of photographs, license numbers, and so on, to an appropriate terminal as needed for a particular application. Such significant benefits suggest that the invention is not obvious, especially considering that the invention has not been implemented or disclosed in the art of record.

Regarding Claim 7, Examiner suggests that Weichert discloses means (billing function 312) for providing transaction information to the first means.

However, since Weichert does not disclose the first means as indicated above, Weichert necessarily does not disclose sending transaction information thereto.

Regarding Claim 8, Examiner suggests that the notes field 716 of Fig. 7A (discussed in paragraphs 82-84) discloses a means for enabling a user to specify selection rules or criteria that dictate which account is automatically selected by the first means (of Claim 1) based on the transaction information obtained via the fourth means (of Claim 7).

However, the user note field 716 of Weichert is merely a field wherein a user can enter notes, such as warnings or preferences (as discussed in paragraph 82). Nowhere does Weichert disclose a fifth means for allowing specification of selection rules or criteria that dictate which account is automatically selected via certain biometric information by the first means. In addition, Weichert does not disclose, as recited in Claim 8, a fifth means that further enables the selection rules or criteria to be further based on the transaction information. For example, unlike Weichert, an embodiment according to Claim 8 might enable a user to automatically charge dinners to a Discover(R) card; to charge airfares to an American Express(R) card; and to charge gasoline to a MasterCard(R). Alternatively, a user may specify that transactions above a certain dollar amount be charged to one account, and transactions below a certain dollar amount be charged to another account (as discussed, for example, on page 12, lines 16-25 of the present Application). Such functionality may yield significant previously unanticipated results in enabling users to organize, categorize, charge, and account for various expenses. Such significant results suggest that the invention is not obvious, as discussed more fully below.

In rejecting Claim 8 under 35 USC 102, Examiner suggests that paragraphs 82-84 of Weichert discuss means for enabling a user to specify selection rules or criteria that dictate which account is automatically selected.

However, instead, Weichert discloses use of various fields in a user interface, such as a drop-down list that lists accounts in a particular order according to some

scheme as discussed in paragraph 84. Note that merely displaying a list of accounts in a priority order is entirely different than employing biometric information to automatically select an account based on certain criteria.

Hence, Weichert neither teaches, discloses, nor suggests use of selection rules that dictate or control *automatic* selection of an account, let alone selection of an account based on transaction information or biometric information.

Claim 8 was slightly modified to more clearly recite the subject matter that was intended to be claimed. In particular, the phrase "based on said transaction information" was repositioned in the claim.

Regarding Claim 9, Examiner suggests that the account information 706 (paragraph 80) of Weichert discloses a sixth means for employing transaction type information to limit automatic selection of account numbers to only those account numbers that are associated with accounts that are compatible with the transaction type.

However, note that paragraph 80 of Weichert does not disclose use of transaction type information to limit automatic selection of account numbers. Rather, Weichert implies that a user must manually select which account to use from the pull-down field 702 of Figs. 7A, 7B. The available funds field 704 generally informs the user of available funds (paragraph 80) and is not employed by the system of Weichert to automatically limit selection of certain accounts as recited in Claim 9.

Regarding Claim 10, Examiner suggests that the database 324 of Weichert discloses the database as claimed.

However, Weichert does not suggest that the database 324 is used to alter selection rules associated with user accounts, since the user manually performs account selections in Weichert (via pull-down field 702 of Figs. 7A, 7B).

The term "account information and/or" was removed from Claim 10 to avoid potential confusion.

Regarding Claim 11, Examiner suggests that the POS interface 180-7 as discussed on paragraph 54 of Weichert discloses a means for automatically providing transaction information to a charging terminal.

However, note that the POS interface 180 is not a charging terminal, but rather an interface that provides information to the terminal 170 and/or 160, as indicated above. Hence, Weichert does not teach, disclose, or suggest the invention as claimed in Claim 11.

Regarding Claim 15, Examiner suggests that Weichert shows a biometric reader 516, an authentication processor 335, and a payment enabler 170, as illustrated in Figs. 11A-12B of Weichert, which are sufficient to disclose the invention as claimed.

However, the authentication processor 335 of Weichert is merely involved in verifying the identity of an account holder. Weichert does not disclose or suggest a mechanism for *automatically* selecting an account and authorizing the account based on one or more biological characteristics (second means). Furthermore, nowhere does Weichert disclose a mechanism for providing a transaction signal in response to automatic biometric-based account selection *and* authorization (second means).

Note that the method flow diagrams of Figs. 11A-12B discuss use of biometric information, i.e., biological characteristics, for authentication/verification purposes only. Nowhere does Weichert state that biometric information is employed to select a particular account from plural accounts of a user, let alone authorize an account for charging. For example, Weichert does not suggest that the account-choosing step 1140 of Figs. 11A and 12B is automatic, rather Weichert provides a manual pull-down menu 702 (Fig. 7B) for account selection.

Regarding Claim 16, Examiner suggests that Weichert discusses (in paragraphs 71-73) a mechanism for providing a signal based on one or more biological characteristics, the signal being an account-selection signal (in addition to being an authorization signal and an authentication signal) upon which a transaction signal is based.

However, the biometric information obtained by the biometric reader 516 and relayed back to the payment enabler 170 as discussed in paragraph 71 is for authentication purposes, i.e., to verify the identity of the user (as suggested in paragraph 72), before an account is authorized for charging. For example, see Fig. 12A, step 1216, wherein biometric information is gathered *after* account information is provided. Note

that in Weichert, the biometric information does not authorize payment, rather the biometric information of Weichert verifies identity, and payment authorization occurs instead in step 1164 of Figs. 11B, 12B.

Regarding Claim 17, Examiner suggests that the database 324 selectively outputs account information contained in a transaction signal that is sufficient to disclose the second means as recited in Claim 15 and 17. Note that in rejecting Claim 15, Examiner suggests that the authentication processor 335 anticipates the second means and provides a transaction signal. Furthermore, note that in Claim 17, the second means necessarily includes that database, since the database provides the transaction signal. *However, since the authentication processor 335 of Weichert does not include the database 324 of Weichert, Weichert clearly does not disclose the second means as recited in Claim 17.* Even if the database 324 of Weichert was included in the authentication processor 335 of Weichert, Weichert would still not teach, disclose, or suggest the invention as claimed.

Clearly, the database 324 does not receive biometric information (first signal) and provide transaction information (account information) in response thereto. Nowhere does Weichert teach use of biometric information as a database key to enable a database to authenticate a user *and* to select an account *and* to provide account information, such as an account number and PIN, in response to the account selection and user authentication. To conclude that the database 324 uses biometric information, Weichert must at least suggest that the database 324 receives biometric information. Instead, the authentication processor 335 (not the database 324) purportedly employs the biometric information verify user identity.

Regarding Claim 18, Examiner suggests that Weichert discloses, such as in paragraphs 77-84, a mechanism that enables a user to selectively control which account is automatically selected by the second means (database) in response to the first signal (biological characteristics).

However, the payment enabler 170, which purportedly provides an option for users to prioritize accounts, does not automatically select accounts, and furthermore, does not enable a user to control which accounts are automatically selected. Instead,

Weichert teaches that accounts are manually selected from a pull-down field (such as 702 of Fig. 7A) and that access to an account involves manual navigation of an interface (Figs. 6-10).

While Weichert purportedly suggests prioritizing a list of accounts, nowhere does Weichert suggest enabling a user to control which account is automatically selected by a database. Prioritization of a list of accounts is different than automatically selecting an account. Even if an account occurs at the top of the prioritized list, the account is not selected. Prioritizing a list or otherwise providing a list is different than selecting an account. *The figures of Weichert clearly imply that a user must at least press the authorize button (Figs. 7A, 7B, 9A, 9B) to perform a selection. Accordingly, any account selection occurring in Weichert would surely not be automatic.* (Emphasis added.)

Regarding Claim 19, Examiner suggests that the biometric reader 516 and card/check reader 512 of Weichert anticipates the means for identifying a user as recited in Claim 19.

However, since Weichert does not disclose or suggest the invention as Claimed in Claim 18 from which it depends, Weichert does not disclose or suggest the invention as recited in Claim 19.

Regarding Claim 20, Examiner suggests that the enabler interface 320 (Fig. 3) of Weichert discloses a means for enabling a user to predetermine account selection rules sufficient to disclose the invention of Claim 20.

However, note that accounts of Weichert are not selected in response to a charge initiated by a system, as recited in Claim 20. Instead, Weichert requires a user to manually (not automatically) select an account for charging (such as via pull-down field 702 and authorize button of Fig. 7A) and requires a user to manually select an authorize button. While Weichert purportedly teaches prioritization of accounts, such prioritization does not constitute selection of an account for charging (i.e., in response to a charge) as claimed.

Claim 20 was corrected to depend from Claim 17 instead of Claim 19, as intended.

Regarding Claim 21, Examiner suggests that Figs. 6A, 7A, 7B of Weichert disclose a remotely positioned terminal (away from the point-of-sale) that constitutes the means for enabling a user to predetermine account selection rules.

However, the screen shots of Figs. 6A, 7A, 7B are purportedly implemented via the POS terminal 508, which is not positioned remotely from the point-of-sale. Instead, Weichert clearly implies (in the name itself) that the Point-Of-Sale (POS) terminal 508 is positioned at the point-of-sale.

Certain embodiments of the present invention may enable a user to configure the system at home or via other remote terminal away from the point-of-sale. This may results in potentially significant benefits, especially in terms of reduced checkout lines at merchant outlets, such as stores, restaurants, and so on. The system of Weichert apparently requires the navigation of potentially complicated or intimidating user interfaces at a point-of-sale, which may be particularly problematic.

Regarding Claim 22, Examiner suggests that Weichert discloses, in paragraph 65, a database (second means) for employing biological characteristics (first signal) to authenticate a user *before* providing a transaction signal (account information/number) to the third means for implementing a funds transfer.

However, instead, paragraph 65 of Weichert suggests that biometric information is merely employed to facilitate verifying identity, i.e., performing authentication. Note that account information (transaction signal) may be provided (such as via the card/check reader 512 of Fig. 5) before biometric information is provided (via the biometric reader 516), as suggested in the ordering of steps 1212 and 1216 of Fig. 12A. If the initially provided account information fails to yield a successful charge, then another account may be selected, such as described with reference to step 1140 of Figs. 11A and 12B and further discussed in paragraph 102 of Weichert.

Regarding Claim 23, Examiner suggests that Weichert further discloses a mechanism (such as in paragraph 65) for storing information pertaining to one or more biological characteristics of a user when authentication fails. Examiner further concludes that since the authentication processor 335 has access to stored information in the user database 324 for each account holder along with information from the money

handlers 160, that risk of fraud could be scored for each transaction to allow a varying fee to be applied that reflects varying insurance costs for fraud risk.

However, this conclusion or suggestion does not appear in Weichert and would be unobvious in view thereof. The conclusion requires hindsight. Instead, Weichert suggests that authentication may be performed to varying degrees, which generally corresponds to a fraud risk (as indicated in the top quarter of paragraph 65). This implies that, for example, a higher degree of authentication may be performed when a higher risk of fraud exists. This does not state or suggest that biological characteristics are stored *when* authentication fails as recited in claim 23.

Regarding Claim 24, Examiner suggests that the payment enabler 170 of Figs. 2 and 3 represents a third means that includes a credit card, charge card, and/or ATM card charging module, and the transaction signal includes a credit card, charge card, or ATM card number and any relevant pins or dates, as purportedly discussed in paragraphs 39-54 of Weichert.

However, the payment enabler 170 does not represent a third means for implementing a funds transfer from a credit card, charge card, and/or ATM card account based on a corresponding number and relevant pins or dates, i.e., a *transaction signal, which is automatically selected and provided to the third means* (via the second means, as recited in Claim 15) *based on one or more biological characteristics.* (Emphasis added.)

Instead, the payment enabler 170 at most discloses a system for facilitating authentication, payment conversion, interfacing with money handlers 160, and so on, in response to manual user input from the POS terminal 508. Nowhere does Weichert suggest that account numbers, PINs, or dates are automatically provided to the payment enabler 170 (which purportedly may already include such numbers) based on one or more biological characteristics.

Furthermore, note that the suggestion that the payment enabler 170 represents a credit card, charge card, and/or ATM card charging module, further implies that the invention as recited in Claim 1, for example, is not anticipated by Weichert. Since Weichert certainly does not disclose automatically providing an account number to the

payment enabler 170 based on or in response to biometric information as recited in Claim 1. Hence, Weichert does not teach, disclose, or suggest the invention as claimed in Claims 1-24.

Note that Claim 24 was corrected to depend from Claim 15, as intended.

In summary, Weichert employs biometrics for user identification/authentication only (page 3, column 1, paragraph 42), i.e., to verify or confirm identity (page 4, column 2, paragraph 54, bottom quarter of the paragraph). Applicant in no way claims that use of biometrics for authentication alone is new. Nowhere does Weichert teach, disclose, or suggest use of biometric information to automatically select or retrieve account information from a database to *a charging* terminal. In addition, Weichert does not teach, disclose, or suggest use of biometric information as a database key (such as recited as the first means limitation of Claim 1 and as discussed more fully on page 10, lines 12-15 of the present Application) to retrieve payment information, such a preferred credit card number, to a credit-card charging terminal or other charging terminal. Instead, Weichert suggests use of biometric information to allow a user to access account information via a user interface. The account information is not automatically delivered to a charging terminal based on the account information.

Embodiments of Weichert generally require a user to manually select an account for charging, such as via a user interface. Weichert generally neither discusses automatic *selection* of an account based on predetermined rules nor discusses automatic retrieval of the selected account information to a conventional terminal. Note that sorting or prioritizing a list of accounts is different than selecting an account as discussed in the present application.

Rejections Under 35 U.S.C. 103(a)

In rejecting Claims 12-14 under 35 U.S.C. 103(a) Examiner admits that Weichert does not disclose a mechanism for wirelessly interrogating product tags associated with products to be purchased; price information associated with a product tag; or a deactivation process for a tag. However, Examiner suggests that Kipp (U.S.

Patent No. 5,239,167) discloses a checkout system that discloses radio frequency tags and that the combination of Kipp and Weichert are sufficient to disclose or anticipate the invention as claimed in Claims 12-14.

Kipp purportedly discloses a system for unassisted checkout in applications involving wireless interrogation of randomly disposed articles in a container. However, Kipp does not disclose or suggest disabling anti-theft alarm-triggering features on a tag. For example, the distress signal emitted by a tag of Kipp (as discussed in column 4, lines 39-48 Kipp) is not an anti-theft signal, but instead, the distress signal alerts an employee to a product that may, for example, require manual pricing. Furthermore, the distress signal is only triggered after the tag is activated at the checkout. A thief is unlikely to pass a checkout line to activate a tag before exiting a merchant outlet.

The combination of Kipp and Weichert would show at most a system for providing a total to be charged based on Kipp coupled to a system that suggests a second payment account for paying the total when the first payment account is inadequate (as discussed in the Abstract of Weichert). Such a combination would not teach disclose or suggest the invention as claimed and would lack various benefits, including anti-theft provisions, automatic checkout, and so on.

The alarm-triggering features disclosed in the present application are adapted to prevent theft of merchandise. Accordingly, Claim 14 was amended to more clearly specify that the alarm-triggering features claimed are anti-theft features as discussed in the specification, in light of which the claims should be read.

The References Cited Address Different Problems

Examiner relies upon Weichert and Kipp to reject the claims. However, these references take different approaches to solve mutually different problems that are different from the problem addressed by the present invention. Hence, they should not be used alone or in combination to reject the invention as claimed (**In re Wright**, 6 USPQ 2d 1959 (1988)).

In particular, Kipp purportedly discloses a checkout system for wirelessly interrogating randomly disposed articles in a container, while Weichert discloses a payment management system for making a payment via a payment account. Accordingly, the references address different problems, and they should not be combined to reject the present invention.

Furthermore Weichert addresses a different problem than that of the invention as claimed and should not be employed to reject the claims. For example, the picking of a payment account from among plural accounts when one account is determined in appropriate for a particular transaction (as discussed for example on page 2, column 1, last half of paragraph 29 of Weichert), is different than addressing checkout lines and waits associated with use of cards or complex user interfaces, as addressed by certain embodiments of the present invention.

Unsuggested Combination Of References

The references cited do not suggest, expressly or implied, that they be combined to teach the invention as claimed. The references take mutually exclusive paths and reach different solutions to different problems. Hence, they should not be combined as maintained by **In re Wright**, 6 USPQ 2d 1959 (1988). Furthermore, strained interpretations were relied upon to combine the references to reject the claims.

In the above-identified Office Action, the suggestion to combine features from the various references to show the present invention has not come from the prior art references themselves. Prior art references themselves should suggest that they be combined for rejection of claims under 35 U.S.C. 103, which was forcefully stated, for example, in **In re Sernaker**, 217 U.S.P.Q. 1, 6 (CAFC 1983):

> "[P]rior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings."

Nothing in the prior art references suggests any advantage to be obtained from their combination. The combination of references cited by Examiner required hindsight.

In **In re Ratti**, 270 F.2d 810, 123 USPQ 349 (CCPA 1959), the court reversed a rejection based on a combination of references, holding that the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." (123 USPQ at 352.). Similarly, combining the cited references in the manner suggested to disclose the invention as claimed would require substantial unobvious reconstruction and redesign of constituent elements. In addition, if the references cited were simply combined without significant modification, the resulting combination would not teach, disclose, or suggest the invention as claimed and would reflect a change in basic principle under which the invention as claimed is designed to operate.

The system of Kipp is a stand alone system that is individually complete. It is unclear how Kipp should be modified for use with the system of Weichert. Such a combination would likely require special hardware and/or software (to interface the systems) that is not taught or suggested in the art. Accordingly, the combination of Weichert and Kipp would be unobvious.

Furthermore, if it were obvious to couple a system for wirelessly interrogating product tags with a system that enables automated payment via biometric information, then surely it would have been done due to the significant advantages afforded thereby as discussed more fully below.

While use of Kipp may expedite checkout in certain applications, one of the most time consuming tasks, i.e., paying for the merchandise, is not addressed by Kipp, and Weichert requires potentially slow and cumbersome interaction with a relatively complicated user interface. Accordingly, combination of Kipp with the teachings of the invention as claimed is not obvious. Otherwise, such a combination would surely have been made due to the virtual elimination of checkout lines that would result.

Such a result represents a synergistic benefit, since any reduction in or elimination of an individual user's time spent paying for merchandise translates into time savings for all customers in line. The elimination of the line results in additional significant, potentially unexpected or previously unanticipated results, namely, more customers will likely be attracted to merchants that do not have lines, thereby increasing merchant business. Such synergistic benefits suggest that the invention as claimed is not obvious.

Furthermore, the invention of Weichert would theoretically require modifying a preexisting charging terminal (such as a money handler 160 of Fig. 2 of Weichert) to work with the payment enabler 170. This is unlike embodiments of the present invention, which are adapted for use with preexisting charging terminals, and hence, may more readily work with existing infrastructure.

Unexpected Results And Significant Advantages

In **In re Wiechert,** 370 F.2d 927, 152 USPQ 247 (CCPA 1967) a significant improvement over the related art was held sufficient to rebut prima facie obviousness based on close structural similarity. Similarly, in **In re Waymouth**, 499 F.2d 1273, 182 USPQ 290, 293 (CCPA 1974), the court held that unexpected results for a claimed range as compared with the range disclosed in the prior art had been shown by a demonstration of "a marked improvement, over the results achieved under other ratios, as to be classified as a difference in kind, rather than one of degree." The present invention provides a marked improvement over the references cited or combinations thereof, as discussed more fully below.

Evidence of unexpected properties may be in the form of a direct or indirect comparison of the claimed invention with the closest prior art (see **In re Boesch**, 617 F.2d 272, 205 USPQ 215 (CCPA 1980) and MPEP 716.02(d) - 716.02(e)). Hence, Applicants' following comparisons of the present invention with the art of record should be sufficient to establish unexpected properties.

The invention as claimed provides several potentially significant benefits over the art of record. For example, users no longer need to repeatedly interact with a potentially complex user interface when checking out. This expedites checkout lines; obviates the need for users to carry a credit card, ATM card, etc., which are subject to loss or theft; accounts of one's choosing may be selected with different biometric information, thereby obviating the need to carry plural cards to have plural account-charging options, and so on.

For example, unlike Weichert, an embodiment, such as according to Claim 8, might enable a user to automatically charge dinners to one type of card and to charge airfares to another type of card. Alternatively, a user may specify that transactions above a certain dollar amount be charged to one account, and transactions below a certain dollar amount be charged to another account (as discussed, for example, on page 12, lines 16-25 of the present Application). Such functionality may yield additional significant previously unanticipated results in enabling users to organize, categorize, charge, and account for various expenses.

As another example, unlike Weichert, embodiments of the invention as claimed, such as in Claim 23, may facilitate identifying fraudulent charge attempts and by maintaining suspect biometric information that may be employed by authorities to facilitate pursuing fraud perpetrators.

Unlike Kipp, the invention as claimed, such as in claim 14, may be employed to thwart product theft, facilitate rapid checkout, and simultaneously facilitate totaling of product prices. Hence, in light of various significant advantages afforded by embodiments of the invention as claimed, the invention is not obvious in view of the art of record either alone or in combination.

The invention as claimed may employ biometric information to both authenticate a user and to select a preferred account in accordance with predetermined rules. In certain embodiments, these rules are configurable by a user and do not require the user to be at the point of sale to perform the configuration. Rather, the user can perform this configuration via the Internet once (or as desired). Hence, a user may pay for items using their iris, for example, instead of a credit card number. For example, a user may choose

to associate one credit card with the left iris and another credit card with the right iris (see Claim 6). This association may be done, for example, via an online website before a user ventures out go shopping. Once this initial association/configuration is performed, a user may make purchases at merchants equipped with an embodiment of the present invention without requiring interaction with a cumbersome user interface with various pull-down menus that must be navigated at the point-of-sale. Use of the menus required by Weichert at the point of sale may require additional time, which contributes to lines and additional wasted time. Such wasted time is saved via use of embodiments of the present invention.

Embodiments of the present invention may employ a synergistic use of biometric data and payment information to reduce lines at merchant outlets and to facilitate purchasing in general. Weichert merely discloses use of biometric data as a way to authenticate a user to enable a user to access account information, not as a way to select a particular account or account number for charging via the system. Using biometric information to allow access to account information is entirely different than using the biometric information to select particular account information and then have this account information automatically delivered to a pre-existing charging terminal, such as a conventional credit card payment terminal.

Weichert admits (page 3, column 1, paragraph 41, last quarter of the paragraph) that the payment enabler stores information for receiving money from credit cards in a conventional way, such as via account numbers, PIN, etc. If Weichert had indeed anticipated that biometric information could be used to obviate the need for a complicated POS interface, then surely Weichert would have disclosed it here, considering the significant benefits afforded thereby. Additional exemplary benefits include; the entering of PINs, signing of receipts, clicking login or authorize buttons, and so on, are no longer required. A user may configure the system of the present invention once, and additional configuration may not be required when making purchases.

Furthermore, if Weichert had anticipated the invention as claimed, then surely Weichert would have noticed that use of the magnetic stripe would be redundant if

biometric information could already be employed to both authenticate and select an account for use. For example, see reader 512 of Fig. 3.

Unlike the invention as claimed, Weichert requires user interaction with a POS terminal (page 4, column 2, paragraph 54, top half of the paragraph), which requires the user to interact with screens and likely wait in line at a checkout station. This is unlike the present invention, which may virtually eliminate lines and requires little or no interaction with a terminal other than, perhaps glancing at a purchase total and then an iris scanner. The resulting scanned biometric information then acts as both a selector and an authenticator to retrieve appropriate charging information to a charging terminal, which may be implemented via a conventional credit card terminal. Hence, considering the significant benefits afforded by use of the invention as claimed and the fact that the invention has neither been implemented nor anticipated, the invention is clearly not obvious.

Omission of an Element

Unlike the present invention, which does not require a user interface other than a biometric scanner at the point of sale, Weichert requires a point-of-sale terminal that can retrieve and display a list of payment accounts for selection by the payer, as discussed, for example on page 2, column 1, the last half of paragraph 32. The payer must then select which account is to be charged at the point of sale. Embodiments of the present invention omit such an interface at the point of sale, the interface of which must be navigated via relatively complicated menus and would likely delay checkout lines. Accordingly, the invention as claimed is not obvious in view of Weichert, or an embodiment lacking the POS terminal 508 or other POS interfaces 180 would be shown.

Request That Subsequent Action Not
Be Final If New Art Is Cited (per MPEP 706.07(a))

Applicant asserts that all modifications to the claims by this Amendment are reasonable. Note that no new limitations or mechanisms (limitations that were not already present or implied in the Claims) were added. Consequently, such amendments should not necessitate citation of additional references. Accordingly, if Examiner cites additional art in the subsequent Office Action, Applicant requests that the action not be made final per MPEP 706.07(a) (¶ 3) to enable Applicant time to respond to the additional references. Furthermore, since Applicant is seeking to define Applicant's invention in claims that will give applicant justly entitled patent protection, prosecution should not be prematurely cut off (MPEP 706.07).

Request for Assistance Pursuant to MPEP 707.07(j)

Since the claims define novel matter that produces new, unexpected, not suggested, and unanticipated results as described above, Applicant submits that such claims are clearly patentable. Therefore, it is submitted that patentable subject matter is present. If Examiner agrees that Applicants have presented patentable material but does not feel that the present claims are technically adequate, Applicants respectfully requests that Examiner write acceptable claims or provide corresponding suggestions pursuant to MPEP 707.07(j).

Conclusion

None of the references cited by Examiner taken alone or in combination teaches, discloses, or suggests the invention as presently claimed. For example, none of the references shows a system that can employ biometric information to automatically provide or send an account number to a charging terminal (Claim 1) or to automatically select and deliver an account number to a charging terminals in response to receipt of the biometric information (Claim 3).

The art (Prorock et al. (US 2002/0169673)) cited but not applied has also been considered. The art would not, either alone or in combination with other cited art, teach,

disclose, or suggest the invention as presently claimed. For example, Prorock purportedly discusses use of a fingerprint to authorize a manager to perform an override function via a point of sale terminal. Hence, Prorock also addresses a different problem than that addressed by the invention as claimed. As in Weichert, Prorock purportedly uses biometric information to perform authentication/authorization to identify a manager and in no way teaches, discloses, or suggests use of biometric information to automatically provide an account number, such as a credit card number, to a charging terminal to obviate the need for shoppers to carry credit cards, enter PINs, login to accounts, remember account numbers or PINs, separately authorize payments, or perform other time-consuming tasks at a merchant checkout line.

The present Application is believed to be in proper form for allowance. Accordingly, allowance, and passage to issue are respectfully requested.

I hereby certify that this correspondence is either being transmitted to the United States Patent and Trademark Office at 571-273-8300 or is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Commissioner for Patents P.O. Box 1450, Alexandria, VA 22313-1450, on June 16th, 2006.

Respectfully submitted,

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